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3 UNITED STATES PATENT AND TRADEMARK OFFICE
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5
6 BEFORE THE BOARD OF PATENT APPEALS
7 AND INTERFERENCES
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10 Ex parte PAUL H. ROBB
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13 Appeal 2008-1856
14 Application 09/732,008
15 Technology Center 3600
16

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19 Oral Hearing Held: October 22, 2008
20
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23 Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and STEVEN
24 D.A. McCARTHY, Administrative Patent Judges

25
26 ON BEHALF OF THE APPELLANT:
27

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34 The above-entitled matter came on for hearing on Wednesday, October 22,
35 2008, at the U.S. Patent and Trademark Office, 600 Dulany Street,
36 Alexandria, Virginia, before Virginia Johnson, Freestate Reporting, Inc.

PROCEEDINGS

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MS. BEAN: Calendar Number 16, Mr. Ali.

4

JUDGE CRAWFORD: Good morning, Mr. Ali.

5

MR. ALI: Good morning.

6

JUDGE CRAWFORD: We had a chance to discuss the case briefly

7

so --

8

MR. ALI: Okay.

9

JUDGE CRAWFORD: -- begin whenever you're ready.

10

MR. ALI: I'm sorry, I didn't hear the last thing you said.

11

JUDGE CRAWFORD: You can begin whenever you're ready. I'm

12

sorry.

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MR. ALI: Let me say I'd like to start by giving some background and

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set up the -- some of the context here, then I'd like to briefly address the

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rejections, then I'd be glad to answer any questions you might have.

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Just to set this up, essentially what our client has invented is an online

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collaboration system where client is --

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JUDGE MCCARTHY: Counsel, is there anything in the specification

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that indicates what the word collaboration means in the context of the

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claims?

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MR. ALI: I think that the, the term collaboration is used throughout

22

the specification but, for example, on page 1 right there at the field of the

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invention refers to collaboration really as the interaction between clients and

24

their, and their -- generally advisors.

25

We use the term participants for anybody who accesses the system on

26

behalf of a client to provide services on behalf of a client, but really

1 participants generally include advisors such as financial advisors, medical
2 advisors, educational advisors --

3 JUDGE MCCARTHY: And is there --

4 MR. ALI: It's kind of a generic term.

5 JUDGE MCCARTHY: -- a specific definition in the specification?

6 MR. ALI: For collaborate?

7 JUDGE MCCARTHY: Yeah.

8 MR. ALI: In a few places identified here. There's the one on page 1.
9 On page 4, lines 10 through 13, we refer to advisors being able to access
10 client information to collaborate as a team. And among other things, what
11 that might include is sharing information, devising plans, addressing client
12 concerns, basically performing services on behalf of a client.

13 As you can see in Claim 1, for example, we refer to clients are able to
14 request services of their participants or advisors. And so really what
15 collaboration encompasses is any kind of interaction between clients and
16 their advisors or participants and also between those participants on behalf
17 of a common client. That could involve exchange in client data, performing
18 various common services on behalf of that client, so it's any kind of, you
19 know, working together between the client and one or more participants, as
20 well as --

21 JUDGE CRAWFORD: So -- but what do you mean by --

22 MR. ALI: -- participants working together.

23 JUDGE CRAWFORD: -- collaboration tool?

24 MR. ALI: Collaboration tool is just kind of a generic term that we
25 have used to describe the tool that's being used by the client and the various
26 participants to work together on behalf of that common client.

1 Essentially what this is is an online system -- a Web enabled system --
2 JUDGE MCCARTHY: And if I may interrupt one more time, I see
3 you use the word enables several times in Claim 1. I was wondering if
4 there's a, a definition or, or what guidance there is in the specification
5 concerning the meaning of that term.

6 MR. ALI: Well, essentially, we're using enabling and various other
7 terms here. You know, we're not trying this so we can coin any of these
8 terms. They're relatively well known, and we're using them in their plain
9 English sense. But these terms are provided in various different places in
10 the specification. For example, on page 4 again, right there, lines 5 through
11 7, enabling a client to authorize selected advisors. So in essence, what that
12 enabling would be is to -- because we see a feature of this online system
13 where a client can go through and select various different advisors to access
14 certain forms of data that belong to that client.

15 Another place where that's provided is on the next page, line 5 -- 15
16 through 20.

17 JUDGE LORIN: So would the ability to access data be, be the key to,
18 to what constitutes enabling?

19 MR. ALI: I'm sorry?

20 JUDGE LORIN: Would the ability to access data be the key to what
21 constitutes enabling?

22 MR. ALI: In terms of enabling access to client's data, yes. So
23 essentially, you know, like I said before that this is a system where clients
24 can interact with various different advisors -- different participants. So that
25 enabling step is not only to choose which advisors are going to be accessing
26 that system on behalf of the client, but also to determine what types of data

1 that -- those different participants might be able to access. For example, like
2 if you have one participant for real estate and another for tax, there might be
3 certain overlap there where the real estate advisor and the tax advisor both
4 need to access the same documents, for example, leading to a real estate
5 transaction. There might be other cases where the tax advisor performs
6 certain services on behalf of the client that had nothing to do with real estate
7 and vice versa.

8 So there's the different enabling that access to client data is also
9 allowing the client to kind of -- it's basically an element of control that's
10 given to the client in terms of defining how participants interact with the
11 system on behalf of that client.

12 JUDGE LORIN: All right, counsel, I have a question for you here.

13 MR. ALI: Yes.

14 JUDGE LORIN: You're discussing this collaboration between, say,
15 an advisor and a client, but we're focusing on Claim 1 that's representative
16 of what you are claiming as your invention, and on reading this claim I don't
17 see any collaboration going on.

18 MR. ALI: That would be in, in the final step. Well, it's kind of -- if,
19 if you look through the, the focal step -- claims in their full context, that's
20 kind of where it all comes together. And essentially -- well, the first step
21 when enabling authorization of one's participants, that sets up the system in
22 terms of defining who is going to be collaborating with the client. In this
23 next step of enabling a client and a participant to submit client data, that is
24 basically a collaboration regarding that client data.

1 Sometimes the client might select their own data. Sometimes advisors
2 or participants might be working with that data and submit that, okay, and
3 it's in the next step --

4 JUDGE LORIN: Let me, let me stop you again, counsel. This
5 question came up before when we -- when Judge McCarthy asked about the
6 definition of enabling and your explaining what the purpose of this will be,
7 what you're intending to do, but the claim calls for enabling. The claim
8 doesn't require actual authorization to occur. Right?

9 MR. ALI: Right, but what it does require is, is a method that requires
10 --

11 JUDGE LORIN: It to be --

12 MR. ALI: -- that has the features --

13 JUDGE LORIN: -- to be capable of doing it?

14 MR. ALI: Right.

15 JUDGE LORIN: Right. So is your argument say -- is your argument
16 that the prior art is incapable of doing that?

17 MR. ALI: There's no discussion of, of such capability, no, in the
18 prior art.

19 JUDGE LORIN: All right. Going back to the question of what is a
20 collaboration tool, when I read your specification my understanding is that
21 collaboration was nothing more than a data base.

22 MR. ALI: It's, it's -- I mean, a data base is definitely part of it.
23 That's essentially where the client data might be stored, where various client
24 documents might be stored, but there's also, you know, various systems that
25 interact with those data bases in terms of user interfaces, ways of, ways of
26 controlling access to that information. And so in addition to the data bases

1 that actually include the information, there's also the front-end systems that
2 provides interfaces to that data base in a specific way.

3 JUDGE LORIN: Can you tell me where in the specification what
4 you're saying is described?

5 MR. ALI: If you look at Figure 1, basically what you have is the
6 collaboration to an -- the interfaces with these various data bases, client data
7 bases which might include various forms of client data, advisors' data bases
8 which include data that the advisors might be working with. And then these
9 front-end modules are what provide, what provide access to those data bases
10 and what regulate the manner in which both clients and participants can
11 interact with that data.

12 JUDGE LORIN: Figure 1 which is explained on page 9 of the
13 specification states that system 100 is for collaborating with a client.

14 MR. ALI: Right.

15 JUDGE LORIN: Collaboration tool -- because the claim does not, the
16 claim does not mention a collaboration system. The claim refers to
17 collaboration tool which is element 120, okay, in Figure 1. Figure 1 is
18 element 120 which shows a module and other -- in Figure 1. There are four
19 pieces to this collaboration tool.

20 MR. ALI: Right.

21 JUDGE LORIN: All right, these modules --

22 MR. ALI: And if you also look in Figure 2 and 3, they provide
23 further details regarding specifically what's involved with that client
24 module. In Figure 3 it specifically took --

25 JUDGE LORIN: -- which are further boxes.

26 MR. ALI: I'm sorry.

1 JUDGE LORIN: These are further boxes. Advisor module in Figure
2 3, there are four boxes: select clients, select activity, results, update
3 mystery; another, another number of boxes on Figure 4. All right, each one
4 of these boxes, when I look at the specification they appear to be -- there's
5 no discussion of software. There's no discussion of algorithm as far as I can
6 tell.

7 MR. ALI: Well, these are, these are basically modules -- are
8 analogous to software modules. Yeah, these are well known terms, you
9 know. I'm not trying to claim anything new here in terms of the form of, of
10 software there. It's essentially a Web-based system, and so there is, you
11 know, various software modules that provide the functionality that we're
12 describing throughout the specification.

13 JUDGE LORIN: Right. And on page 9 you discussed data bases
14 which provide the information you need for your intended collaboration.

15 MR. ALI: Right.

16 JUDGE LORIN: Go ahead. So going back to Claim 1, you have
17 steps for enabling, enabling these functions, enabling -- and my question to
18 you again is you have prior art which shows computers with data bases
19 providing information. Why would it not be capable of doing what you're
20 saying in the claim?

21 MR. ALI: Well, I -- in terms of Zognovich (phonetic sp.), for
22 example, there is no, there's no software. There's no block. There's, there's
23 nothing in there that describes a way of enabling a client. For example, it
24 wasn't exactly clear what the Examiner was referring to as the client versus
25 the participant. But assuming -- I think the way it seemed to me was that the
26 Examiner is referring to the contributor sort of the researchers who are

1 providing research documents as being the clients. So in that context I
2 suppose that the -- what those research reports are what they would consider
3 a client data.

4 Now, for example, in Sub C where we were saying referring to
5 enabling a client to submit one or more requests for one or more services to
6 the collaboration tool, so what that would be would -- if you were to try to
7 read that into this reference, there would have to be some sort of mechanism
8 in this reference which describes those contributors who are producing these
9 research documents of submitting requests for services, and there's nothing
10 like that in here.

11 So essentially them pushing information into these data bases and then
12 defining how they can be accessed so there's no services that can be
13 performed on behalf of these contributors. There's no discussion or
14 anything along those lines, so in that sense -- although it generally -- any
15 system could, could be rewritten to enable certain features, that doesn't
16 necessarily mean that it's been disclosed as such in these references.

17 JUDGE LORIN: The Examiner had a difficulty here with the way --
18 with, with the terms you're using because there's a 112 second and a number
19 of these terms the Examiner did not understand. And from what I
20 understand here is that you're saying you're using them in a normal use of
21 the terms that you find in the definition in, in a dictionary, correct? These
22 are just plain meaning? These terms are just plain meaning?

23 Then the Examiner had difficulty in the prior art in understanding
24 what precisely that the invention is here, and I think your argument is that
25 there's no, there's no collaboration. There's no -- between a participant and
26 a client there's no meeting of the minds discussing the future, the future use

1 of the data that's being requested and, and being transferred between the
2 participants.

3 MR. ALI: Well, again, the way that the, the way that the claims are
4 structured is not necessarily to, quote/unquote, you know, "affirmatively
5 represent" that these things are happening, but to have a method that, that
6 allows these things to happen.

7 In any given situation, you know, some of these steps may or may not
8 necessarily occur, but the way in which we're trying to claim this is to get at
9 a method that allows all of these things to occur using this type of system
10 that has all these different features enabled. And in a different case of a
11 specific client and their participants, they may or may not use some or all of
12 these features.

13 But in any event, we're referring to a method that's being employed
14 using this collaboration tool, that has all these different features enabled
15 whether they choose to be used. And if the reference --

16 JUDGE MCCARTHY: So you're saying that this method might be
17 performed without actually forming each step of authorizing or submitting
18 client data et cetera?

19 MR. ALI: Well, no. Like I said before, you know, this is a Web-
20 based system, so essentially once the system goes live, you know, we have
21 all these, you know, server farms interacting with these data bases. Once the
22 server goes live, all these different features are kind of, you know, turned on,
23 and at that point, yes, these things are happening as various different features
24 are enabled in the system. And that's -- that --

25 JUDGE MCCARTHY: So the features are enabled when they're
26 turned on --

1 MR. ALI: Right. Correct. That's generally, you know, how, how
2 these types of Web-based systems are, are, are referred to, is not necessarily
3 performing any, you know -- users can come to these systems and interact
4 with them in many different ways, and that's kind of the way that these
5 systems are set up, is to have all these different features where users can
6 make what they want out of the system.

7 And all these different features are enabled and they can access them
8 in different ways in accordance to their specific needs, and that's really what
9 we're trying to get at here in terms of specific way of doing that in this
10 environment of, of clients and participants in terms of participants, of
11 course, being advisors here.

12 And there's a lot of problems generally where there's this overlap of
13 data, where different advisors might use the same data for the same client.
14 And really what this is is putting that all in the same place in order for that to
15 be able to work together. And so really that, that is what this is, is a system
16 that performs this method of allowing this type of collaboration exchanging
17 of client data, requesting services on behalf of that common client using the
18 system.

19 JUDGE MCCARTHY: So is it fair to characterize the, the four steps
20 as essentially being modules or sets of instructions or processes within the
21 computer that are capable of performing the -- these -- the steps if called
22 upon?

23 MR. ALI: Yeah, that's basically our view, is, you know, once this
24 collection of processing devices, servers, data bases, and everything, once
25 that goes live, various modules on those servers will be configured for
26 execution.

1 JUDGE MCCARTHY: And the method then would be completed
2 once the system is turned on?

3 MR. ALI: Correct.

4 JUDGE LORIN: Then all those, all those different features would be
5 enabled and then thereafter perhaps one or more clients might actually go
6 ahead and authorize participants to use client data? Various clients or
7 participants might then choose to use the feature of submitting client data
8 and so on? You know, clients might use the system to submit requests and
9 so on like that?

10 JUDGE LORIN: And so what you're saying is that you're applying
11 certain instructions in your modules that enable you to accomplish what
12 you're intending to accomplish, this collaboration?

13 MR. ALI: Right.

14 JUDGE LORIN: And that those instructions are not disclosed in the
15 prior art?

16 MR. ALI: Correct.

17 JUDGE LORIN: Okay.

18 MR. ALI: Right.

19 JUDGE LORIN: Where are those instructions in the specification?

20 MR. ALI: Well, they would be resident within these various modules.
21 I mean, if we did --

22 JUDGE LORIN: Well, what are they? I mean, apparently the
23 software -- you have certain software, certain code --

24 MR. ALI: Yeah, it's software, you know, software that's been coded
25 and --

1 JUDGE LORIN: Well, where's the code? Where's the code in the
2 specification?

3 MR. ALI: It's within the modules. I'm sorry, I mean --

4 JUDGE LORIN: Well, I understand it's within the modules --

5 MR. ALI: Right.

6 JUDGE LORIN: -- but where's the code, where's the code described?
7 Where, where is it in the specification? I don't see any code here.

8 MR. ALI: Oh, no, we -- I mean, it's not necessarily specifically stated
9 in code, but basically what these modules are are software that have -- we're
10 -- you know, it's described in terms of the functionality. As far as the
11 specific instructions, specific codings, you know, there's various examples
12 later on in the specification that we described different ways in which these
13 things interact with the system, but you know, generally in the way that the
14 software applications are drafted we try to put them in functional terms.

15 In terms of the specific instructions, the specific code, it's kind of
16 secondary. It's a specific implementation deep down, and what we're really
17 trying to get at is the functional aspects, how those interact with the system.
18 Basically, you know, when you're describing these Web-based systems it's
19 really about how a user comes to the system and how it appears to them
20 there. What goes on behind, behind the scenes in these various modules in
21 terms of how they specifically run on these processors is kind of secondary,
22 not necessarily --

23 JUDGE LORIN: Is it secondary? Are you saying that it's common
24 knowledge to program these modules to be able to do what they're doing?

25 MR. ALI: Not specific -- once you take these specific functions --
26 once they're described -- once you know how to do A, B, C, and D in terms

1 of enabling the collaboration, you know, between clients and participants,
2 developing specific instructions in, in code -- in source code to implement
3 those things is probably within the scope of somebody who has ordinary
4 skill. But then you still have to start with knowledge of the end result. You
5 know, it's kind of the way that, you know, software is often developed, is
6 you start with an idea of this is our goal, this is what we're trying to
7 implement, and then you kind of work backwards from that and say okay
8 how do we go about that? Maybe we write code in this way and I use these
9 different modules, these different packages, and go about implementing that,
10 but generally that's the way that software development occurs. It's kind of
11 backwards from functionality, and that's what we're trying to get to here, is
12 the functionality of the system.

13 JUDGE MCCARTHY: If I might turn you to Claim 20. I notice that
14 steps A, B, C, and D are listed as means for, it appears to be, performing
15 certain functions --

16 MR. ALI: Um-hum.

17 JUDGE MCCARTHY: Is it proper to interpret those under Section
18 112, paragraph 6, and if so can you provide us some guidance on the
19 corresponding instructions in the specification?

20 MR. ALI: Sure. Let me just find the Appeal Brief where it refers to
21 that. Again, you know, before I look specifically at the specification, if this
22 was to be interpreted under 112 6th -- one thing I would note is that, you
23 know, generally 112 6th is only invoked when there's not sufficient structure
24 in the specification -- or I'm sorry, in the claim in itself.

25 Here we are referring to this client -- this electronic collaboration tool
26 in the sense that that's not structure in itself because maybe it -- like I said

1 before, it's, it's a software module that's configured to execute on various
2 processors and servers. Then perhaps 112 6th could be invoked, but again,
3 then that -- those means would apply specifically to those servers, servers,
4 processors, et cetera that are configured to execute those modules. And for
5 those I would just point to the various discussions of the different systems
6 that we have that allow these things to occur.

7 JUDGE MCCARTHY: Well, if it's in your Brief, we
8 can --

9 MR. ALI: On page 22 and on from there is where we talk about the
10 specific architecture that's used in order to make the system run. And
11 essentially what would happen is that these modules would be deployed on,
12 on this architecture and then turned on live for Web access.
13 So for example, you have a central information processing hub, central large
14 scale computers, communication links, these various things that together
15 form the online system. And once you put all those things together, those
16 would be the various means.

17 JUDGE LORIN: Well, counsel, I would like you to be aware of the
18 fact that the Federal Circuit has been issuing decisions which has been
19 clarifying the law in this area, that if the invention lies in the software it will
20 have to be disclosed in order to comply with 112 2nd. In the recent decision
21 *Net Moneyin Inc.*, that came out this week, the Federal Circuit stated that the
22 means-plus-function claim element where the disclosed structure is simply a
23 general purpose computer is invalid under 112 2nd unless an algorithm is
24 disclosed, which goes back to my point about the instructions here. If you
25 disclose no instructions and you simply say it's a general purpose computer
26 that performs these functions, that would be insufficient.

1 MR. ALI: Well, obviously, that's one piece of the puzzle, but then
2 again I would refer again to those modules, and those provide the specific
3 instructions and algorithms. I'm sorry, excuse me, the instructions per se as
4 far as code is not in our specification. That's not what we're trying to -- like
5 I said before, we're trying to get the functional aspects, and so those would
6 kind of encompass the algorithms.

7 For example, authorization can refer to, you know, Page 12-13 where
8 we describe the ways in which clients can authorize their different advisors.
9 That would provide some of the algorithms for the way in which that is
10 carried out. Step B in terms of data means is for enabling a client or
11 participant to submit client data. Again throughout we have various -- page
12 12, line 14 onward we describe the way in which client data can be
13 reviewed, admitted. Page 13, line 5, client may view summary or detailed
14 analysis information provided by associated advisors and participants.

15 So again, these provide different -- different ways, different
16 algorithms perhaps or ways in which these steps can be carried out. Request
17 means for enabling the client to submit one or more requests. Let me find
18 the place that that -- page 12, line 14, client may submit questions or
19 requests, enter comments, to some or all participating advisors.

20 In one example client made a request to a specific advisor to update a
21 file or make changes to a document. So again the algorithms, if that's what
22 you're looking for, would be the ways in which these steps are described
23 functionally. Specifically, most -- predominantly in Figures 1 though 3
24 describing the way in which those modules would operate.

25 JUDGE CRAWFORD: You have any further questions?

26 JUDGE LORIN: No, I'm fine.

- 1 JUDGE CRAWFORD: You? Thank you.
- 2 MR. ALI: Okay, great.
- 3 (Whereupon, the hearing concluded on October 22, 2008.)